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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/745,464	12/26/2000	Takeo Katsuda	018656-194	3991
21839	7590	04/17/2006	EXAMINER	
BUCHANAN INGERSOLL PC (INCLUDING BURNS, DOANE, SWECKER & MATHIS) POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404			BRINICH, STEPHEN M	
			ART UNIT	PAPER NUMBER
			2625	

DATE MAILED: 04/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/745,464	<b>Applicant(s)</b> KATSUDA, TAKEO	
	<b>Examiner</b> Stephen M. Brinich	<b>Art Unit</b> 2625	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

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**DETAILED ACTION**

***Response to Arguments***

1. Applicant's arguments, see Response filed 3/27/06 (page 9, line 12 - page 11, line 20), with respect to the rejections of claim(s) 1-4 & 6-16 under 35 USC §102 and the rejection of claim 5 under 35 USC §103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Shen, Weinreich et al, and (re claim 5) Yacoub.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4 & 6-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shen in view of Weinreich et al.

Re claims 1-3, 11, & 13-14, Shen discloses (Figures 5 & 8; column 4, line 45 - column 6, line 2) a secure printer in which an image and an associated password are generated, and an

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authorized recipient is designated by an e-mail address. The image data and password are transmitted to the recipient electronic mailbox over a network by e-mail (Figure 5, step S506) and further transmitted to a selected destination printer (Figure 8, step S805; column 5, line 23). The selected destination printer prints out the image data if (and only if) the printout is certified by entering the matching password into the printer (Figure 8, steps S809-S811; column 7, lines 19-31).

Shen does not disclose the transmission of the password to the user via e-mail separately from the transmission of the image data. The e-mail transmission of a password separately from other information associated with that password (i.e. information that requires the password for secure retrieval) is disclosed by Weinreich et al (column 22, line 44 - column 23, line 19, particularly column 22, lines 44-49).

Shen and Weinreich et al are combinable because they are from the field of data security using password protection.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the Weinreich et al arrangement of password retrieval in association with the Shen arrangement of password protection of image data.

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The suggestion/motivation for doing so would have been to enable a user who has forgotten his password to print image data protected by the Shen security arrangement.

Therefore, it would have been obvious to combine Shen with Weinreich et al to obtain the invention as specified in claims 1-4 & 6-15.

Re claim 2, Shen further discloses (Figure 1, item 10) a scanner for inputting the original image data, but does not disclose that this scanner receives a printer and recipient designation and transmits data to the recipient by e-mail. The latter functions are performed by the computer (1), or more specifically by its CPU (15) (column 5, lines 45-49). Thus, the aggregate of the scanner (10) and computer (1) of Shen is readable upon the "scanner" recited in claim 2.

Re claims 3, 9, & 11-12, Shen discloses the transmission of the image data and password are transmitted to two devices (the electronic mailbox and the printer). The transmission of both data items to both devices is readable upon the claim language reciting that one is transmitted to one device and the other is transmitted to another device, in the absence of a specific statement that each data element is transmitted *only* to one or the other.

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Re claims 4 & 6, Shen further discloses that the password is requested prior to printing (Figure 8, step S811; column 7, lines 26-31) and prior to transmission (Figure 5, step S504; column 7, lines 20-27).

Re claims 7 & 8, Shen further discloses (Figure 5, step S504; column 7, lines 20-27) that the e-mail address (which inherently designates a message recipient) is entered.

Re claim 9, Shen further discloses (Figure 1, item 10) a scanner for reading image data.

Re claim 10, Shen further discloses (column 5, lines 64-65) the storage of the received image data in an electronic mail box.

Re claim 12, Shen further discloses (Figure 1) that the printing and networking operations are computer-based (which inherently requires the computer to be executing instruction derived from a computer readable medium).

Re claim 15, Shen discloses (Figure 1) the use of a computer (1) at a user station connected to the Internet (12). The computer of the document-receiving user station would read on the recited "first computer"; the computer of the document-sending user station would read on the recited "second computer"; and the password would read on the recited "certification information".

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4. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shen in view of Weinreich et al as applied to claim 4 above, and further in view of Yacoub.

Re claim 5, Shen in view of Weinreich et al does not disclose the generation and receipt of completion notification in response to password entry and image formation (i.e. printout).

The generation of a message indicating the completion of printing inherently constitutes a completion notification in response to image formation. Insofar as correct password entry is a prerequisite for image formation in the secure printout system of Shen, such a "Print Complete" message is also inherently in response to correct password entry. Thus, a display which notifies the user of the completion of a print job upon receipt of a print-complete signal transmitted from the printer control to the display) reads on the recited "receiving unit".

Shen in view of Weinreich et al does not expressly disclose the generation and display of such a "Print Complete" message. The generation, transmission, and display of a message indicating the completion of printing is well known in the art as disclosed for example by Yacoub (column 9, lines 32-41).

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Shen, Weinreich et al, and Yacoub are combinable because they are from the field of printers.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to generate, transmit, and display a "Print Complete" message for the Shen printer.

The suggestion/motivation for doing so would have been to notify a user that a printout was ready for pickup.

Therefore, it would have been obvious to combine Shen in view of Weinreich et al with Yacoub to obtain the invention as specified in claim 5.

#### ***Conclusion***

1. Any inquiry concerning the contents of this communication or earlier communications from the examiner should be directed to Stephen M. Brinich at 571-272-7430.

Any inquiry relating to the status of this application or proceeding or any inquiry of a general nature concerning application processing should be directed to the Tech Center 2600 Customer Service center at 571-272-2600 or to the USPTO Contact Center at 800-786-9199 or 703-308-4357.

The examiner can normally be reached on weekdays 7:00-4:30, alternate Fridays off.

The examiner's unit designation has been changed from "Art Unit 2624" to "Technology Division 2625" (as of March 20, 2006).




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If attempts to contact the examiner and the Customer Service Center are unsuccessful, supervisor David Moore can be contacted at 571-272-7437.

Faxes pertaining to this application should be directed to the Tech Center 2600 official fax number, which is 571-273-8300 (as of July 15, 2005).

Hand-carried correspondence may be delivered to the Customer Service Window, located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314.

  
Stephen M Brinich  
Examiner  
Technology Division 2625

smb  
April 13, 2006